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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,208	01/30/2004	Robert James Suttner	1832	7580

27310 7590 05/06/2005

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/769,208

Applicant(s)

SUTTNER ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. Claims 1-8 are pending.
2. The specification is objected to for the blank lines on pg 46, lines 5 and 6.

#### ***Claim Objections***

3. Claims 6 and 8 are objected to because of the following informalities:

Claim 6 starts with an improper article.

In claim 8, line 1, "comprising" should be replaced with --, wherein the method comprises--.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8 are rejected under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If a seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted

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that Applicant intends to deposit seeds for XB53J04 at the ATCC, but there is no indication that the seeds have been deposited and there is no indication in the specification as to public availability. If the deposit of these seeds is made under the terms of the Budapest Treaty, then an affidavit or declaration by the Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. A minimum deposit of 2500 seeds is considered sufficient in the ordinary case to assure availability through the period for which a deposit must be maintained.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit, meets the criteria set forth in 37 CFR 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;

(d) the viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.801 - 1.809 [MPEP 2401-2411.05] for additional explanation of these requirements.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

Claims 1 and 7 are indefinite in their recitation of "ATCC Accession No. \_\_\_\_\_", because the ATCC Accession No. is missing.

Claims 1 and 7 are indefinite in its recitation of "soybean variety XB53J04", given that a name does not clearly identify the claimed soybean cultivar and seed, and does not set forth the metes and bounds of the claimed invention. Since the name XB53J04 is not known in the art, the use of said name does not carry art recognized limitations as to the specific characteristics or essential characteristics that are associated with that denomination. In addition, the name appears to be arbitrary, and the specific characteristics associated therewith could be modified, as there is no written description of the soybean plant that encompasses all of its traits. Amending claims 1 and 7 to recite the ATCC deposit number would overcome the rejection.

Claim 8 is indefinite because it lacks agreement between the preamble of the methods and the product produced. Methods must be circular; the final step must generate the item the method is intended to produce. It is suggested that --progeny-- be inserted after "a" in line 4.

***Claim Rejections - 35 USC § 102 - 35 USC § 103***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Streit et al (1999, US Patent 5,959,185).

The plants of the instant application, XB53J04, and the plants taught by Streit et al, 95B41, have the same traits including, hilum color (black), pubescence color (tawny), flower color (white), pod color (tan), Maturity group (V), and resistance to soybean cyst nematode race 3, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score, relative maturity, and mean yield. Furthermore, methods of crossing XB53J04 soybean would be the same as the methods of crossing prior art soybean cultivar 95B41. Thus, the XB53J04 soybean plant and methods of its use, appear to be identical to the 95B41 plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to 95B41, then it appears that 95B41 only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would not confer a patentable distinction to XB53J04 plants. Similarly, the methods of crossing XB53J04 soybean would be the same as the methods of crossing prior art soybean cultivar 95B41. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by 95B41 soybean plants and methods of their use.

11. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Conway (1999, US Patent 5,920,001).

The plants of the instant application, XB53J04, and the plants taught by Conway, CX496C, have the same traits including, hilum color (black), pubescence color (tawny), flower color (white), pod color (tan), Maturity group (V), susceptibility to *Phytophthora*, and resistance to soybean cyst nematode race 3, for example. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score and mean yield. Furthermore, methods of crossing XB53J04 soybean would be the same as the methods of crossing prior art soybean cultivar CX496C. Thus, the XB53J04 soybean plant and methods of its use, appear to be identical to the CX496C plant and methods of its use.

Alternatively, if the claimed plants and seeds of the instant invention are not identical to CX496C, then it appears that CX496C only differs from the claimed plants and seeds due to minor morphological variation, wherein said minor morphological variation would not confer a patentable distinction to XB53J04 plants. Similarly, the methods of crossing XB53J04 soybean would be the same as the methods of crossing prior art soybean cultivar CX496C. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by CX496C soybean plants and methods of their use.

### ***Conclusion***

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

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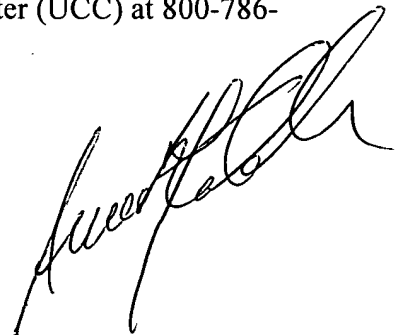
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.  
April 29, 2005



ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER